

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-21 are currently pending in the application. Claim 1 has been amended. No claims have been added or cancelled. Therefore, claims 1-21 are present for examination. Claims 1, 9, and 10 are independent claims. No new matter has been added by the amendments.

Prior to entry of this amendment, the application included claims 1-21. A non-final office action mailed September 23, 2008, has rejected claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,266,180 to Karkare et al. ("**Karkare**"), in view of U.S. Application Publication No. 2004/0006760 A1 to Gove et al. ("**Gove**"). Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication No. 2005/0172306 A1 to Agarwal et al. ("**Agarwal**"), and further in view of U.S. Application Publication No. 2003/0229677 A1 to Allan ("**Allan**").

35 U.S.C. §103 Rejection, Karkare in view of Gove

Claims 1-21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Agarwal and further in view of Allan. Applicants respectfully request reconsideration of the rejection because the Examiner has failed to show a *prima facie* case of obviousness.

Claim 1:

The Office Action does not note the specific components of the component repository, the development environment, the development runtime environment, or the data collector. For example, the Final Office Action fails to demonstrate which component in Karkare is the component repository or the data collector. Indeed, the particular teaching or associations between the cited art and the claim terms could not be found by the Applicants.

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(c)(2)

The Examiner is requested to specify which components in Karkare are:

1. the component repository;
2. the development environment;
3. the development runtime environment;
4. the data collector.

Missing limitation: “determining an application component to be monitored in the IDE, the application component having associated information in a component repository of the IDE runtime environment, wherein the component repository is configured to provide a list of components that is available to be invoked by the IDE runtime environment”

Claim 1 requires “determining an application component to be monitored in the IDE, the application component having associated information in a component repository of the IDE runtime environment, wherein the component repository is configured to provide a list of components that is available to be invoked by the IDE runtime environment.” The Examiner states that Karkare shows this limitation in Fig. 4 or Fig. 6. *See Office Action*, p. 3. Figure 4 only shows an application and not a repository of application components and does not show separate components. Likewise, Fig. 6 only shows running an application and does not show a repository of separate components. Gove does not overcome the limitations of Karkare because Gove does not show or describe a repository. *See Gove*, ¶¶ [0024]-[0032]. Therefore, claim 1 is allowable over the cited art for at least this reason.

35 U.S.C. §103 Rejection, Agarwal in view of Allan

Claims 1-21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Agarwal and further in view of Allan. Applicants respectfully request reconsideration of the rejection because the Examiner has failed to show a *prima facie* case of obviousness. Examiner argues that the provisional applications, U.S. Provisional Patent Application No. 60/437,441 (“441 Application”) and 60/437,443 (“443 Application”), “merely are problem

statements and solution descriptions and thus, do not fully support the disclosure and limitations recited in claims of the instant application.” *Office Action*, p. 2. Applicants disagree. A patent application is fundamentally only a problem statement and solution description. The provisional applications provide description of the claim elements. The Applicants now provide citations to portions of the provisional applications to support the claim elements.

Claim 1:

Limitation: “A method for integrating runtime metrics into an integrated development environment (IDE), the IDE including a runtime environment and a user interface environment, the method comprising”

Support for this limitation is found in the ‘441 Application, Drawing 2 and p. 1 (“By extending the reach of IDEs to incorporate runtime information from production deployments . . .”).

Limitation: “determining an application component to be monitored in the IDE, the application component having associated information in a component repository of the IDE runtime environment, wherein the component repository is configured to provide a list of components that is available to be invoked by the IDE runtime environment”

Support for this limitation is found in the ‘441 Application, pp. 1-3 (“Developers can selectively subscribe to alerts for their modules generated in production deployments;” and “Automatically register all new components into a virtually central repository.”). Support for this limitation is also found in the ‘443 Application, pp. 1 and 2 (“Automatic publication of new components . . .” “the developer will simply go to the runtime tab and connect to the production-system manager.”).

Limitation: “monitoring the application component in the IDE runtime environment to determine a plurality of metrics associated with the application component”

Support for this limitation is found in ‘441 Application, Drawing 2 and pp. 1 and 2 (“Developers get real-world feedback on stability and performance characteristics of the application . . .” “The IDE plugin automatically connects to the management application and

obtains the relevant performance and stability characteristics . . .”). Support for this limitation is also found in the ‘443 Application, Drawing 2.

Limitation: “transmitting the plurality of metrics to a data collector of the IDE user interface;”

Support for this limitation is found in ‘441 Application, p. 3 (“Such data obtained can also be used to automatically highlight components in appropriate panes in the IDE for closer scrutiny by the developer.”). Support for this limitation is also found in the ‘443 Application, Drawing 1 (Runtime IDE view), p. 2 (“[T]he IDE plugin queries the appropriate management application and requests performance or stability data . . .”).

Limitation: “displaying the metrics to a user of the IDE”

Support for this limitation is found in ‘441 Application, pp. 1 and 2 (“The IDE plugin automatically connects to the management application and obtains the relevant performance and stability characteristics that it then displays to the developer.”) Support for this limitation is also found in the ‘443 Application, Drawing 1.

The other independent claims and many of the dependent claims (i.e., claims 2-21) have similar features that are also described in the provisional applications. As such, this application should be given the priority date of the provisional applications.

Therefore, the combination of Agarwal and Allan is indeed improper. One of the references used, namely Agarwal, is not prior art under any section of 35 U.S.C. § 102. Indeed, to form an obviousness rejection under 35 U.S.C. § 103, each reference used in the rejection must be prior art under one or more sections of 35 U.S.C. § 102. See MPEP § 2141.01. Thus, if any reference used in the obviousness rejection is not prior art under 35 U.S.C. § 102, the Examiner has failed to state a *prima facie* case for the obviousness rejection.

The present application claims benefit of the filing date from two provisional applications: U.S. Provisional Application No. 60/437,441 and U.S. Provisional Application No. 60/437,443. Both of these provisional applications have a filing date of January 2, 2003. Thus, the priority date for the present application is January 2, 2003.

The filing date for Agarwal is October 20, 2003. Thus, the filing date for Agarwal is a full 10 months after the priority date of the present application. As such, Agarwal cannot be considered prior art to the present application under any section of 35 U.S.C. § 102. The use of Agarwal in this obviousness rejection is improper. Applicants respectfully request that the Examiner withdraw this rejection and issue a notice of allowance.

Claims 2-8:

Claims 2-8 depend, either directly or indirectly, from allowable independent claim 1. Thus, claims 2-8 are allowable over the cited art due, at least in part, to this dependence from an allowable base claim.

Claim 9:

Claim 9 includes claim terms similar to allowable claim 1. For example, claim 9 includes the claim element "to determine an application component to be monitored in the IDE, the application component having associated information in a component repository of the IDE runtime environment, wherein the component repository is configured to provide a list of components that are available to be invoked by the IDE runtime environment." Thus, claim 9 is allowable over the cited art for the same or similar reasons as claim 1.

Claim 10:

Claim 10 includes claim terms similar to allowable claim 1. For example, claim 9 includes the claim element "a component repository configured to maintain a list of available application components that can be invoked by an integrated development environment ("IDE") runtime environment." Thus, claim 10 is allowable over the cited art for the same or similar reasons as claim 1.

Claims 11-21:

Claims 11-21 depend, either directly or indirectly, from allowable independent claim 10. Thus, claims 11-21 are allowable over the cited art due, at least in part, to this dependence from an allowable base claim.

Appl. No. 10/751,333
Amdt. dated December 23, 2008
Reply to Office Action of September 23, 2008

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any argument not specifically addressed herein. Rather, Applicants believe the present amendments and argument overcome all rejections.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Tadd F. Wilson
Reg. No. 54,544

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
T3W:s5s
61700939 v1